

REMARKS/ARGUMENTS

Claims 32 and 40-42 are pending in the application. Claim 32 is the sole independent claim.

Reasons for Pre-Appeal Review

The sole independent claim 1 stands rejected under 35 USC 103(a) as being unpatentable over Seidman (US 5,080,364) in view of Silverbrook et al. (US 6,457,883) and further in view of Stangl (US 7,197,641). The references as applied against claim 1 manifestly fails to support a prima facie case of obviousness.

Obviousness can only be established when three basic criteria are met (MPEP at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*"):

- (1) First, there must be some teaching, suggestion or motivation to combine or modify teachings of the prior art to produce the claimed invention found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
- (2) Second, there must be a reasonable expectation of success; and,
- (3) Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant respectfully submits that the present claims are patentable over Seidman (US 5,080,364) in view of Silverbrook et al. (US 6,457,883) and further in view of Stangl (US 7,197,641), and that a prima facie case of obviousness has not been established.

Seidman teaches electronic data processing apparatus 14 at several redemption locations 12 within a casino. The data processing equipment 14 at each redemption location 12 is connected via standard data linkages to a central digital computer 22. The electronic data processing apparatus 14 incorporates an optical bar code reader 16. In the Office Action dated April 28, 2009 the Examiner acknowledges that Seidman is silent regarding the incorporation and transmission of a sensing device ID and product identifiers in the communication from the bar code scanner, but asserts that Silverbrook teaches the same.

Examiner has offered as motivation to combine the teachings of Seidman and Silverbrook as "It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the transmission of n application alias ID, user ID, pen ID, and UPC product identifiers as taught by Silverbrook in the product entry of Seidmen on order to determine the location, individual, and product associated with the entry and/or user specific context for the exchange of information." That motivation is deficient since the offered motivation but does not come from the prior art.

Additionally, in the claimed invention the sensing device ID received in the data from the sensing device is used to identify a telecommunication address of an entrant in a competition. In the event that the bar code reader 16 of Seidman includes its identity in its communication with the central digital computer 22, that identity would identify the casino, not the entrant. There exists no association between the bar code reader 16 belonging to the casino and the entrant. Thus, if that modification is made, the same would still fail to provide the claimed invention.

As further acknowledged by the Examiner, Seidman and Silverbrook are silent with regards to associating actual and temporary telecommunication addresses, and the transformation between the temporary address and actual address to enable communication. Stangl is relied upon for teaching utilization of a temporary communications address to enable communication to conceal an actual communication address. The motivation offered is as follows: "... in order to conceal the actual communication address of the one part from another".

However, the Office Action has failed to identify where in Seidman in view of Silverbrook it is taught that the competition administrator sends any communication to the entrant, whether directly or indirectly. Seidman in view of Silverbrook does not teach any communication between the competition administrator and the entrant, or that any data with regards to the entrant is communicated from the casino to the competition administrator. There is therefore no motivation to conceal the entrant's actual communications address from the competition administrator.

The FINAL Office Action dated April 28, 2009 fails to establish a prima facie case of obviousness with regards to at least independent claim 32 since:

the offered motivations to combine the references are not from the prior art *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (cited by MPEP §2143.010); and
the prior art references when combined do not teach or suggest all the claim limitations.

CONCLUSION

For these reasons, the Applicant requests favorable consideration of the present application by the pre-appeal review board.

Very respectfully,

Applicant/s:



Kia Silverbrook



Paul Lapstun



Jacqueline Anne Lapstun



Paul Quentin Scott

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: patentdept@silverbrookresearch.com

Telephone: +612 9818 6633
Facsimile: +61 2 9555 7762